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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/932,784 09/18/97 MCKAIN

J A0521/7125

EXAMINER

WM01/0705

PETER J GORDON  
WOLF GREENFIELD & SACKS  
FEDERAL RESERVE PLAZA  
600 ATLANTIC AVENUE  
BOSTON MA 02210

NGUYEN, H

ART UNIT

PAPER NUMBER

2615

DATE MAILED:

07/05/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

08/932,784

Applicant(s)

MCKAIN ET AL.

Examiner

HUY T NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-2 and 4- 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washino et al (5,488,433) in view of Freeman et al (5,579,239) and Osamu (JP405153448).

Regarding claims 1-2, 9 and 23, Washino et al. discloses a digital motion picture recorder (Figs 1 and 2) comprising a motion picture camera (video camera) for providing a motion video signal; means (6, 740) converting the motion video signal into a sequence of digital still images and compressing the sequence of digital still image (column 4, lines 57-68); and means for storing the sequence of digital still images on a

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writable random-access medium (70) in a computer readable file form (column 10, lines 9-25).

Regarding claims 3-4, Washino et al. further discloses a editing system (Fig 2) and a display means (view finder 4)

Regarding claims 5-6, Washino et al. further teaches that the digital medium is a disk- type drive (70) and the disk- type drive is mounted in a housing detachable from the housing of the digital motion picture recorder.

Washino fails to teaches a editing means that specifies sequence of the stored digital still picture . However, it is noted that using a editing means for specifying a sequence of stored digital video signal is well known in the art as taught by Freeman. Freeman teaches an editing means (2) with in a computer for editing a video signal captured from a video camera and recorded on a random access memory (column 2, line 59 to column 3, line 7, column 6, lines 8-20, Fig. 2). Therefore , it would have been obvious to one of ordinary skill in the art to modify Washino with Freeman by installing the editing means as taught by Freeman in the recorder of Washino to enable edit the stored digital still pictures by specify a sequence of the still digital still pictures, thereby providing more convenience to the user in editing the stored digital sill picture.

Washino as modified with Freeman fails to teach that the editing means is with the housing of the recorder. However, it is noted that install editing means within a housing of a recorder is well known in the art as taught by Osamu (JP405153448). Osamu teaches a video camera having an editing means within the housing of the camera .

It would have been obvious to one of ordinary skill in the art to modify Washino as modified with Freeman with Osamu by using the teaching of Osamu to install the editing means as taught by Freeman withing the recorder of Washino thereby provide more convenience to the user in handling the editing the captured digital data.

Regarding claims 4, 10, 24, Washino as modified with Freeman further teaches a display and editing control to edit and display the sequence of the still picture (See Freeman, Fig. 2)

Regarding claims 5,6,12, 13, 15, 26, 27, 40, Washino as modified with Freeman teaches that the medium is a random access medium and a disk type is detachable (Hard disk drives, See Washino and Freeman .

Regarding claim 7, Washino as modified with Freeman fails to specifically teach that the portable housing is ruggedized. However, it is noted that ruggedizing a device is well known in the art and also it is required by customer. Therefore, it is would have been obvious to one of ordinary skill in the art to make the housing of the recorder of Washino as modified with Freeman to be ruggedized in order to provide the digital recorder with more endurance.

Regarding claims 11, 25, 38, Washino as modified with Freeman and Osamu further teaches display functions associated with an input mechanism. See Freeman and Osamu references.

Regarding claims 14,28 and 39, Washino as modified with Freeman fails to the housing comprise a shell and a shock absorbing cushions between the shell and disk type drive. However, it is noted using a shock absorbing cushions to prevent vibration

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and firmly hold a part is well known in the art. Therefore Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Washino as modified with Freeman by incorporating a shell and a shock absorbing cushions between the shell and disk drive to prevent the vibration of the disk.

Regarding claims 16, 17, 30, 31 and 42, Washino as modified with Freeman further teaches the use of data address bus provide data to a computer network (See is well known in the art. Therefor it would have been obvious to one of ordinary skill in the art to modify Peter by providing data address bus to provide still digital images to a computer interface to transmitting the still digital to a designated destination (See Freeman, column 6).

Regarding claims 8, 18 and 32, Washino as modified with Freeman fails to teach the calibration of the color of the still digital picture However, it is noted that using means for calibration color of the picture is well known in the art. Therefore, Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Washino as modified with Freeman by using a means for calibrating the color of the digital still picture in order to improve the quality of the digital still picture.

Regarding claim 19, 33 and 43, Washino as modified with Freeman fails to specifically teach the means for overlaying information indication of time code or date on the digital still picture signal. However, it is noted that overlay date or time code or information on a picture is well known in the art. Therefore the Official notice is taken and it would have been obvious to one of ordinary skill in the art to modify Washino as modified with Freeman by using means for generating time code or date and

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overlaying the date or time code on the digital still picture in order to accurately identify the still picture.

Regarding claims 20,21,34,35 and 44, Washino as modified with Freeman further teaches the use of encoder (compressing means) for encoding the video signal.

Regarding claims 22, 36 and 37, Washino as modified with Freeman further teaches that the digital still picture is conforming with NTSC format.

3. Claims 1-2 and 4- 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters et al (5,946,445) in view of Borman and Osamu (JP405153448).

Regarding claims 1-2, 9 and 23, Peters discloses a digital motion picture recorder comprising:

- a housing sized to be portable for use by an individual (Fig. 1);

- processing means ( Fig. 1) in the housing for receiving the motion video signal from a video camera and a processing the received motion video signal;

- a converting means for converting the motion video signal into a sequence of the still image (column 2);

- storage means (5) for storing the sequence of still images on a computer readable and rewritable random access medium mounted in the housing (column 3).

Peters at fig 1 fails to specifically teach that the motion camera mounted in the housing having the recorder. However, it is noted that combining a camera with recorder for making a portable apparatus is well known in the art as taught by Osamu. Therefore, it would have been obvious to one of ordinary skill in the art to modify the digital recorder of Peters by providing a motion camera in the same housing of the digital

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recorder for portability 's purpose therefore providing more advantages to the user in capture the desired the motion signal .Also See Peter he specification of the instant application page 4) and it is well recognized that a camera which integral with a digital recorder to make portable is well recognized in the art.

Peters as modified with Osamu further teaches the use of an editing unit for editing the recorded digital still picture but fails to specifically teaches that the editing means is used for specifying a sequence of the stored digital picture to be played back.

Bohrman teaches an editing unit which is used with a computer for editing the prestored video information, defining a sequence of the still video information to be reproduced .

It would have been obvious to one of ordinary skill in the art to modify Peters with Bohrman by using an editing device as taught by Bohrman in the apparatus of Peters for editing the video information stored on the medium in order to provide convenience to the user in editing the digital still picture.

Regarding claims 4, 10, 24, Peters as modified with Bohrman further teaches a display and editing control to edit and display the sequence of the still picture (See Peters column 3, lines 30-40 and Bohrman (Fig. 2, column 1, lines 15-25 column 2, lines 15-25)

Regarding claims 5,6,12, 13, 15, 26, 27, 40, Peter as modified with Bohrman teaches that the medium is a random access medium and a disk type is detachable .



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Regarding claim 7, Peters fails to specifically teach that the portable housing is ruggedized. However, it is noted that ruggedizing a device is well known in the art and also it is required by customer. Therefore, it is would have been obvious to one of ordinary skill in the art to make the housing of the recorder of Peters is ruggedized in order to provide the digital recorder with more endurance.

Regarding claims 11, 25, 38, Peter as modified with Bohrman fails to teach display functions associated with an input mechanism. However, it is noted that using display function and an input mechanism associated with display function to enabling a user to select an associated function is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to modify Peters as modified with Bohrman to provide display functions and associated input mechanism in order to provide more convenience to the user in operation the digital recorder.

Regarding claims 14,28 and 39, Peters fails to the housing comprise a shell and a shock absorbing cushions between the shell and disk type drive. However, it is noted using a shock absorbing cushions to prevent vibration and firmly hold a part is well known in the art. Therefore Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Peters by incorporating a shell and a shock absorbing cushions between the shell and disk drive to prevent the vibration of the disk.

Regarding claims 16, 17,30, 31 and 42, Peters fails to specifically teach the use of a data address bus to provide the digital still image to a computer interface. However, it is noted that using a data address bus to provide data to a computer network is well known in the art. Therefor it would have been obvious to one of ordinary skill in the art

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to modify Peter by providing data address bus to provide still digital images to a computer interface to transmitting the still digital to a designated destination.

Regarding claims 8, 18 and 32, Peters fails to teach the calibration of the color of the still digital picture. However, it is noted that using means for calibration color of the picture is well known in the art. Therefore, Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Peters by using a means for calibrating the color of the digital still picture in order to improve the quality of the digital still picture.

Regarding claim 19,33 and 43, Peters fails to specifically teach the means for overlaying information indication of time code or date on the digital still picture signal. However, it is noted that overlay date or time code or information on a picture is well known in the art. Therefore the Official notice is taken and it would have been obvious to one of ordinary skill in the art to modify Peters by using means for generating time code or date and overlaying the date or time code on the digital still picture in order to accurately identify the still picture.

Regarding claims 20,21,34,35 and 44, Peter fails to teach the use of encoder for the digital still picture. However, it is noted that using an encoder for encoding video signal comprising digital still pictures is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to modify Peters by using an encoder for the digital still picture for encoding the digital still picture.

Regarding claims 22, 36 and 37, Peters further teaches that the digital still picture is conforming with NTSC format.

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***Response to Arguments***

4. Applicant's arguments filed April 19, 2001 have been fully considered but they are not persuasive.

In Remarks, applicants argue that there is no reference at the time the invention was made to show a camera within the housing of recorder. However, it is noted that incorporating a recorder with a housing of a camera is well known in the art as taught by Washino and Osamu.

In Remarks, applicants argue that "a portable video system as taught in Peter would still receive a signal from an external device . . . rather than Applicants a putting together a video system including an editor with a camera which is not even part of Peters". In response, it is submitted that when the camera and the digital recorder as disclosed by Peters are put together to form a portable video system, the signal would be received by the video system. Further, it is noted that putting a camera and a digital recorder to form a portable video system is well recognized in the art.

Furthermore, it is noted that using an editor together with a recording/ reproducing apparatus is well known in the art as taught by Bohrman, Bohrman teaches an editor which is used with a recording/reproducing apparatus to edit the video signals.

Therefore, it would have been obvious to one of ordinary skill in the art to using an editor as taught by Bohrman with the digital recorder as taught by Peters to edit the motion picture which comprises a sequence of the still images disclosed by Peters.

Since using an editor in associated with a digital recording/reproducing apparatus

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would provide more convenience to the user in editing the images and this is a motivation that would lead a practitioner in the art to use an editor with the video system of Peters. Since the claimed video system is merely formed by the well-known parts putting together, the combination of a camera, a digital recorder as taught by Peters and the editor as taught by Bohrman would produce the claimed video system.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Blank teaches a recording apparatus having a television camera mounted thereon. Washino et al teaches a multi-format audio/video production system employed with a digital video camera .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

  
HUYNH NGUYEN  
PRIMARY EXAMINER

H.N  
July 1, 2001

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.